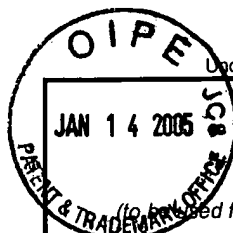


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PTO/SB/21 (08-03)

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<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)	Application Number	10/772,036	
	Filing Date	February 3, 2004	
	First Named Inventor	Ling JONG	
	Art Unit	1626	
	Examiner Name	Rei Tsang SHIAO	
Mail Stop	AMENDMENT	Attorney Docket Number	8500-0264.10

**ENCLOSURES (Check all that apply)**

<input checked="" type="checkbox"/> No fee due <input type="checkbox"/> Fee Transmittal <input type="checkbox"/> Fee(s) due <input type="checkbox"/> Fee Transmittal <input type="checkbox"/> Check for \$* <input checked="" type="checkbox"/> Charge any underpayment or credit any overpayment to Deposit Account No. 18-0580 <input checked="" type="checkbox"/> Return postcard <input checked="" type="checkbox"/> Response to Restriction Requirement <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement & Form(s) PTO-1449 <input type="checkbox"/> Copy(ies) of cited reference(s) <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts / Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s):	<input type="checkbox"/> After Allowance Communication to a Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks:		

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm or Individual Name (print/type)	Mark L. Warzel, Reg. No. 47,264 Reed Intellectual Property Law Group	Telephone	(650) 330-0900
Signature	<i>Mark L. Warzel</i>	Date	January 10, 2005

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Name (print/type)	Mark L. Warzel	Date	January 10, 2005
Signature	<i>Mark L. Warzel</i>		



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Ling JONG et al.

Confirmation No.: 6185

Serial No.: 10/772,036

Group Art Unit: 1626

Filing Date: February 3, 2004

Examiner: Rei Tsang SHIAO

Title: ANALOGS OF INDOLE-3-CARBINOL METABOLITES AS  
CHEMOTHERAPEUTIC AND CHEMOPREVENTIVE AGENTS

**RESPONSE TO REQUIREMENT FOR RESTRICTION**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in response to the Requirement for Restriction mailed December 10, 2004, in which the Examiner required restriction between five groups of claims, as follows:

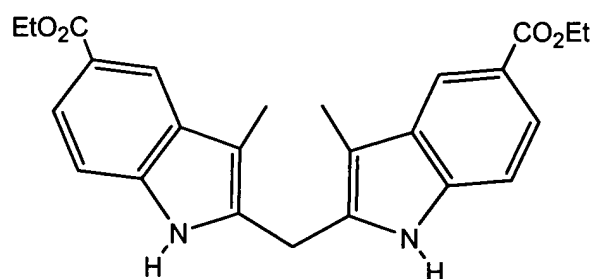
- I. Claims 14-24, 54-58, in part, drawn to compounds/compositions of formula (II), wherein the variables  $R^1, R^2, R^3, R^4, R^5, R^6, R^7, R^8, R^{11}, R^{12}, R^{13}$ , and  $R^{14}$  independently do not represent heteroaryl or heterocycle, the variables  $R^1, R^2, R^3, R^4, R^5, R^6, R^7, R^8, R^{11}, R^{12}, R^{13}$ , and  $R^{14}$  independently are not substituted with heteroaryl or heterocycle; any two adjacent (ortho) variables  $R^1, R^2, R^3, R^4, R^5, R^6, R^7, R^8, R^{11}, R^{12}, R^{13}$ , and  $R^{14}$  are not linked to form a 5- or 6-membered cyclic rings or fused five-membered and/or six-membered ring, or heteraromatic ring having heteroatoms, or heteroalicyclic ring having heteroatoms, the variable X does not represent heteroarylene;
- II. Claims 14-24, 54-58, in part, drawn to compounds/compositions of formula (II), receiving compounds not compassed in the Group I;

- III. Claims 85-97, drawn to methods of use (i.e., treating cancer) of compounds of formula (II), receiving compounds in the Group I;
- IV. Claim 100, drawn to methods of use (i.e., treating estrogen-related diseases) of compounds of formula (II), receiving compounds in the Group I; and
- V. Claims 103, 110-112, drawn to methods of use (i.e., treating viral infection) of compounds of formula (II), receiving compounds in the Group I.

In addition, an election of species was required with respect to a single disclosed compound within the elected group for the purpose of the Examiner's initial search and examination.

In response, applicants elect Group I, claims 14-24, 54-58, in part, drawn to compounds/compositions of formula (II). Applicants make this election with traverse, for the reasons discussed in detail below.

With regard to the species election requirement, applicants elect the following compound, identified as compound 46 (SR 13654) in the application (Example 14):



5,5'-dicarbethoxy-3,3'-dimethyl-2,2'-diindolylmethane

Applicants respectfully traverse the Requirement for Restriction, in part, since the Groups III to V are directed to methods of use of the compounds identified as forming Group I. Notwithstanding the criteria cited in the Office Action, these methods are actually "related" in the context that they involve the use of the same Group of compounds. As such, it seems reasonable that the methods of use of the same compounds should be examined along with the compounds themselves.

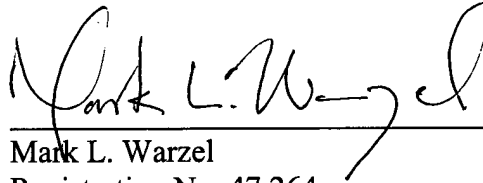
In addition, given the requirement that method of use claims be rejoined with allowable product claims (according to the standards mentioned in the Office Action and set forth in MPEP §821.04), the method of use claims will need to be searched and examined anyway since these claims are dependent claims that depend from independent claim 14.

For at least the foregoing reasons, applicants respectfully submit that the method of use claims identified in Groups III to V should be examined with the compound claims of Group I. In the alternative, applicants request rejoiner of the Groups III to V claims with the Group I claims at the appropriate time.

If the Examiner has any questions concerning this communication, or would like to discuss the application, the art, or other pertinent matters, a telephone call to the undersigned at (650) 330-0900 would be appreciated.

Respectfully submitted,

By:

  
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Registration No. 47,264

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